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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,412	05/11/2001	Richard C. Conrad	AMBI:073US/GNS	7685

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/854,412	Applicant(s) CONRAD, RICHARD C.	
	Examiner David A. Lamberton	Art Unit 1636	

--Th MAILING DATE of this communication appears on the cov r sheet with th correspondence address --

THE REPLY FILED 29 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-61.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 2. NOTE: The After Final Amendment filed 29 October 2003 raises new issues that would require further search and consideration. Specifically, the amendment attempts to enter a limitation for "reducing rRNA carryover" when purifying mRNA from a sample, as well as a method step for "inhibiting partial hybridization of poly(A) mRNA to any rRNA" present in a sample. These limitations appear to be central to the claimed subject matter. However, these limitations were not present in the claims prior to FINAL rejection, and therefore would require a further search and consideration in the determination of patentability after prosecution on the merits has been closed. As such, the After Final Amendment will not be entered for purposes of Appeal because the After Final amendment further complicates the issues by introducing new limitations into the claimed subject matter.

Concerning Applicant's arguments regarding the rejection of claims 1-36 and 61 (method claims), the arguments are moot because they are predicated on the entry of the After Final amendment, which has not been entered. It is noted, however, that Applicant has not provided arguments concerning the rejection of claims 1-61 by Kearney et al. in view of Aviv et al., in further view of Jacobs et al. and Conlan et al. (see pages 7-8 of the FINAL rejection). While it appears that the traversal of the rejection under Kearney et al. in view of Aviv et al. would naturally apply to the traversal of the rejection under Kearney et al. in view of Aviv et al., in further view of Jacobs et al. and Conlan et al., this should be clearly stated on the record in order to make the reply fully responsive.

Concerning Applicant's arguments regarding the kit claims (37-60), Applicant indicates that there is nothing set forth in the Office Action to anticipate or make obvious the claimed kits. Specifically, it is argued that there is nothing to motivate the creation of the kit because none of the references teach the mechanism of rRNA carryover. In response to this argument, it is pointed out that the "kit" as claimed is judged for patentability based on the components within said "kit" (i.e., the kit is simply a physical embodiment of the components within the kit). As it regards the instant claims, the combined teachings of the Kearney, Aviv, Jacobs and Conlan references in the FINAL rejection clearly indicates the presence of all of the components of the claimed "kits" in a physical embodiment. Therefore, by teaching all of the components of the claimed "kits" in a physical embodiment, the combined teachings also teach the "kits" per se. The mechanism of rRNA carryover is irrelevant to the composition as claimed because the mechanism of rRNA carryover is not a physical composition, which is the nature of the kit claim. Therefore, Applicant's traversal is not persuasive to overcome the rejection of claims 37-60.



JAMES KETTER
PRIMARY EXAMINER